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REMARKS

Double Patenting

All claims in the present application are rejected in the Office Action dated September 24, 2004 for obviousness-type double patenting over claims 1-22 of copending Application No. 09/882174, over claims 10-15 of copending Application No. 09/881919, over claims 1-20 of copending Application No. 09/881915, and over claims 1-12 of copending Application No. 09/882173.

The Office Action states that claims 1-60 are rejected as being unpatentable over claims 1-22 of copending Application No. 09/882174 because:

... they are not patentably distinct from each other because the limitations of the independent claims 1, 21, 41 are similar to claim 1 of copending Application No. 09/882174. The limitations "remote direction of streaming digital content from a content server to a client devices using remote director" is equivalent to the use of content information, transcoding gateway for providing director instructions to stream digital content, and the use of email containing digital content. The limitations of dependent claims 2-20, 22-40, 42-60, are similar to claims 2-22 of copending Application No. 09/882174.

The law governing double patenting is that the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) are applied for establishing a background for determining obviousness under 35 U.S.C. 103 and are employed when making an obviousness-type double patenting rejection. The *Graham* factual inquiries require the Examiner to:

- determine the scope and content of the art as described in copending application no. No. 09/882174;

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- determine the differences between the scope and content of the art as described in copending application no. No. 09/882174 and the claims at issue;
- determine the level of ordinary skill in the pertinent art; and
- evaluate any objective indicia of nonobviousness.

The Office Action Fails to Establish the Required
Background for the Double Patenting Rejection

As described above, the Office Action must apply the Graham factors to establish the required background for a double patenting rejection. The Office Action fails to apply a single Graham factor to establish any of the necessary background elements for determining obviousness. In fact, the Office Action does not even mention the *Graham* factors. In the complete absence of any mention or consideration of the Graham factors whatsoever, applicants can offer no further analysis on this issue. The Office Action clearly cannot support an obviousness-type double patenting rejection, and the rejection should be withdrawn.

The Office Action Fails to State Reasons Why a Person of Skill
in the Art Would Conclude that the Claims are Obvious

The Office Action presents no argument why a person of ordinary skill in the art would conclude that claims 1-60 in the present case are obvious in view of claims 1-22 of copending Application No. 09/882174. In fact, the Office Action says not one word regarding why a person of ordinary skill in the art would conclude that claims 1-60 in the present case are obvious in view of claims 1-22 of copending Application No. 09/882174. The Office Action therefore cannot support an obviousness-type double patenting rejection and the rejection should be withdrawn.

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Summary Regarding Double Patenting

The double patenting rejections of the claims of the present application over claims 10-15 of copending Application No. 09/881919, over claims 1-20 of copending Application No. 09/881915, and over claims 1-12 of copending Application No. 09/882173 should be withdrawn for the same reasons as set forth above for the rejections over claims 1-22 of copending Application No. 09/882174. In summary regarding the double patenting rejections, therefore: The Office Action of September 24, 2004, does not establish the necessary background for determining obviousness required by an obviousness-type double patenting rejection. Furthermore, the Office Action fails to articulate reasons why a person of ordinary skill in the art would conclude that claims 1-60 in the present case are obvious in view of claims 1-22 of copending Application No. 09/882174, claims 10-15 of copending Application No. 09/881919, and claims 1-20 of copending Application No. 09/881915. The rejection of claims 1-60 should therefore be withdrawn.

Title of The Application

There is no need to amend the title of the present application. The Office Action states:

The present title is not sufficient for proper classification of the claimed subject matter.

Applicants in response respectfully note that 37 C.F.R. § 1.72(a) requires titles to be "as short and specific as possible." The title of the present application is "Broadcast User Controls for Streaming Digital Content Under Remote Direction." Applicants propose that the title is short, specific, descriptive, and in complete compliance with 37 CFR § 1.72(a). Applicants therefore respectfully decline to amend the title.

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Brief Summary of the Invention

There is no need to amend the Summary. The Office Action states:

The 'Brief Summary of the Invention' should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims.

Applicants respectfully note that 37 C.F.R. §1.73 requires, "Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed." Applicants use claim terminology to assure compliance with 37 C.F.R. § 1.73. Applicants respectfully propose that claim terminology is the very best terminology for compliance with 37 C.F.R. 1.73 because claim terminology is assured to be "commensurate with the invention as claimed." For these reasons, applicants respectfully decline to amend the Brief Summary of Invention.

Claim Rejections – 35 U.S.C. § 103

Claims 1-60 are in the case. Independent claims 1, 21, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over a first reference entitled Application Server Solution Guide, Enterprise Edition: Getting Started, Nusbaum, et al., May 2000, pages 1-45, 416-434 (hereafter 'Nusbaum'), and in view of a second reference entitled Java Media Framework API Guide, JMP 2.0 FCS, November 19, 1999, Sun Microsystems, pages 1-66, 109-135, 173-178 (hereafter 'Sun'). As explained in detail below, applicants respectfully traverse the rejections of the present claims under 35 USC § 103(a).

To establish a prima facie case of obviousness, three elements must be proven by the Examiner. MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify or to combine Nusbaum and Sun. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification or the

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proposed combination of Nusbaum and Sun. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification or the proposed combination of Nusbaum and Sun must teach or suggest all of applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, neither the modification nor the combination of Nusbaum and Sun establishes a prima facie case of obviousness. The rejection of claims 1-10, 13, 15-18, 23-32, 35, 37-40, 45-54, 57, 59-62 should therefore be withdrawn and the case should be allowed.

The Cited References Set Forth No Suggestion to
Modify or Combine Nusbaum and Sun

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify or combine Nusbaum and Sun. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner has not pointed to any disclosure in Nusbaum or Sun suggesting the desirability of the combination. Moreover, there is no possibility whatsoever that the Examiner could ever point to any disclosure in Nusbaum or Sun suggesting the desirability of the combination. Nusbaum in fact makes no mention whatsoever of broadcast user controls, remote directors, or director instructions and therefore could not possibly suggest the desirability of the combination. In addition, no such suggestion occurs in Sun. Absent such a showing of desirability, the Examiner has impermissibly used "hindsight" occasioned by applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The proposed combination of Nusbaum and Sun therefore cannot possibly

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establish a prima facie case of obviousness. The objection should be withdrawn, and the case should be allowed.

There is No Reasonable Expectation Of Success in the
Proposed Combination of Nusbaum and Sun

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Nusbaum and Sun. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The Examiner has not pointed to any disclosure in Nusbaum or Sun suggesting any expectation of success. Absent such a showing of an expectation of success, the Examiner has failed to meet one of the three basic elements of a prima facie case of obviousness. There can be no reasonable expectation of success in a proposed combination with Nusbaum if the proposed combination changes the principles of operation of Nusbaum. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Office Action bases this rejection on the portions of Nusbaum and of Sun which are cited against the elements of claims 1, 21, and 41, that is, against the elements of receiving a director instruction including an identification of a selected user control, extracting the selected user control, identifying a data communications program, encoding in dependence upon the selected user control and downloading a new HTML document, and so on, as claimed in claims 1, 21, and 41. The cited portions of Nusbaum include, for example: figure 5 and 'server containing web content' on page 13; section 1.3.2, page 12; and section 2.1.1.1, pages 31 and 32. The cited portions of Sun include pages 4, page 6, and Appendix A, page 173.

Page 13 of Nusbaum sets forth figure 5 as "EJB environment and interaction with other components," referring to an execution environment for 'EJBs,' Enterprise Java Beans. The Office Action's 'server containing web content' seems to be in section 1.4, page 13, which states:

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JavaServer Pages (JSP) technology provides developers with an easy and powerful way to build Web pages with dynamic content. JSPs dynamically generate HTML, eXtensible Markup Language (XML), ...

Nusbaum at section 1.3.2, page 12, describes "EJB architecture in brief." Nusbaum at section 2.1.1.1, pages 31 and 32, describes "EJS architecture," where 'EJS' stands for 'Enterprise Java Services.' Sun cannot really be said to 'teach' anything. Sun merely provides some definitions regarding streaming media as the terms are used in the Java Media Framework. Sun at page 4 defines some common terms used in streaming media including 'content type,' 'media stream,' 'multiplex,' 'track,' and so on. Sun at page 6 presents a chart of common video and audio formats. Sun at Appendix A, page 173, sets forth source code for a Java Applet operable in the Java Media Framework.

That is, Nusbaum teaches an EJB execution environment and a kind of dynamic web page technology known as Java Server Pages or 'JSP,' and Sun presents some definitions regarding streaming media. As described in Nusbaum, dynamic web page technology is methods and systems for building server pages on the fly. Clearly dynamic web pages generally and JSPs in particular, that is, "Web pages with dynamic content," are not broadcast user controls as claimed in the present application. Broadcast user controls in fact are not and cannot be implemented as part of dynamic web page technology, that is, for building web pages dynamically, without changing the principals of operation of the dynamic web page technology.

For further explanation, applicants note with respect that dynamic web page technology as described in Nusbaum takes as its inputs HTTP REQUEST and HTTP POST messages bearing query data representing parameters whose varying values affect dynamism among web page structures. Dynamic web page technology as described in Nusbaum produces as its outputs HTTP RESPONSE messages. This dynamic web page functionality as described in Nusbaum incorporates and discloses no elements of streaming media, and streaming media functionality as described in Sun cannot be added to it without changing its principals of operation. It cannot possibly be obvious to one of

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ordinary skill in the art at the time of the invention, therefore, to combine Nusbaum and Sun. The proposed combination of Nusbaum and Sun therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn, and the case should be allowed.

Nusbaum Teaches Away From the
Claims of the Present Application

Turning now to the substance of Nusbaum, Nusbaum actually teaches away from the current application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Nusbaum discloses dynamic web page technology with no mention of broadcast user controls. Clearly there would be no impulse on the part of developers of dynamic web page technology to incorporate broadcasting user controls into dynamic web page technology. By effecting dynamic web page technology alone, with no hint or suggestion that broadcast user controls might even exist, Nusbaum teaches directly away from the combination with Sun proposed in the Office Action. Because Nusbaum teaches away from the applicants' claims, the proposed modification of Nusbaum with Sun cannot support a prima facie case of obviousness. The rejection of applicants' claims should be withdrawn and the case should be allowed.

Nusbaum and Sun Do Not Teach
Each and Every Element of the Claim

To establish a prima facie case of obviousness, the proposed combination of Nusbaum and Sun must disclose all of applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). There is not one word in Nusbaum or Sun regarding broadcast user controls, remote directors, selected user controls, identification of selected user controls, extraction of identified selected user controls, identifying data

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communications programs in dependence upon director instructions, encoding HTML documents in dependence upon selected user controls, and so on, as claimed in the present application. The fact that Nusbaum makes some general references to network communications or that Sun makes general references to streaming media is completely insufficient to anticipate or suggest claim elements in the present application. This ground of rejection should be withdrawn.

Nusbaum Cannot be a Reference Against the Claims of the Present
Application Because Nusbaum Represents Nonanalogous Art

Nusbaum cannot be a reference against the claims of the present application because Nusbaum represents nonanalogous art within the meaning of *In Re Horn*, *Clay*, and *Oetiker*. *In re Horn*, 203 USPQ 969 (CCPA 1979), *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The field of the inventors' effort in this case is broadcasting user controls. The present application claims, among other things, receiving a director instruction including an identification of a selected user control, extracting the selected user control, identifying a data communications program, encoding in dependence upon the selected user control and downloading a new HTML document, and so on, as claimed in claims 1, 21, and 41. The field of Nusbaum is dynamic web pages for the World Wide Web – which clearly has nothing to do with the technical field of the present application. Nusbaum therefore is not within the field of the inventor's endeavor in this case.

Because Nusbaum is not within the field of the inventor's endeavor in this case, there can be no basis for believing that Nusbaum as a reference would have been considered by one skilled in the particular art working on the relevant problem to which this invention pertains. That is, there would be no reason for an inventor concerned with broadcasting user controls to search for art regarding dynamic generation of web pages. The two simply have nothing to do with one another. Nusbaum as a reference therefore is not reasonably pertinent to the particular problem with which the inventors were involved in the present case and is not available as a reference against the present application.

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Applicants respectfully propose that for this reason alone the rejection of the present claims should be withdrawn, and the claims should be allowed.

Conclusion

All claims in the present case stand rejected under 35 U.S.C § 103(a). Independent claims 1, 21, and 41 stand rejected under 35 U.S.C § 103(a) over Nusbaum in view of Sun. The combination of Nusbaum and Sun fails to establish a prima face case of obviousness. The applicants have demonstrated that it is incorrect to reject the independent claims 1, 21, and 41 under 35 U.S.C § 103(a). The applicants respectfully propose that all the dependent claims in the present case stand because the independent claims 1, 21, and 41 stand. The rejection of all the claims 1-60 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-60 in light of the present remarks is respectfully requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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